

REMARKS/ARGUMENTS

Favorable reconsideration of this application is respectfully requested.

Claims 24-60 remain active in this case. Claims 33 and 35 are amended to correct a minor informality and Claims 47-60 are added by the present response. Support for amendments and additions to the claims is found in the disclosure as originally filed. Thus, no new matter is added.

In the outstanding Office Action, Claims 25, 29, 37 and 42 were rejected under 35 U.S.C. §101, as directed to non-statutory subject matter; Claims 31 and 44 were rejected under 35 U.S.C. §102(b) as anticipated by ISO/IEC 13818-1 Standard (Generic Coding of Moving Pricutures and Associated Audio: Systems, International Organization for Standardization, Workgroup 11 - Coding of Moving Pictures and Associate Audio, Pages 1-130, 13 Nov. 1993, herein "ISO/IEC"); Claims 24-27, 29-31, 33, 35, 37-39 and 42-44 were rejected under 35 U.S.C. §103(a) as unpatentable over ISO/IEC in view of Bruls et al. (U.S. Pat. Pub. No. 2006/0098937, herein "Bruls") and Yahata et al. (U.S. Pat. Pub. No. 2009/0010614, herein "Yahata"); Claim 28 was rejected under 35 U.S.C. §103(a) as unpatentable over ISO/IED, Bruls and Yahata in further view of Kelly et al. (U.S. Pat. Pub. No. 2002/0191625); Claims 32, 34, 40 and 55 were rejected under 35 U.S.C. §103(a) as unpatentable over ISO/IED, Bruls and Yahata in view of Kim et al. (Fine Grain Scalability in MPEG-4 Audio, Audio Engineering Society, 111th Convention of the AES, 24 Sept 2001, Pages 1-5, herein "Kim"); Claims 36, 41 and 46 were rejected under 35 U.S.C. §103(a) as unpatentable over ISO/IED, Bruls and Yahata in view of Wu et al. (U.S. Pat. No. 6,614,936, herein "Wu").

With regard to the rejection of Claims 25, 29, 37 and 42 under 35 U.S.C. §101, as directed to non-statutory subject matter, Applicants respectfully traverse this rejection.

The Action states that these claims are directed to an abstract idea because the claims are not directed to a particular machine, as the “information processing apparatus” of claims 25, 29, 37 and 42 is capable of being implemented on any machine that is capable of performing the recited steps.

In response, Applicants respectfully submit that the Action’s evaluation of whether these claims are directed to an abstract idea is improper.

For instance, the USPTO’s “Interim Guidelines for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos*” specifically states that

Taking into account the following factors, the examiner should determine whether the claimed invention, viewed as a whole, is disqualified as being a claim to an abstract idea. Relevant factors—both those in favor of patent eligibility and those against such a finding—should be weighed in making the determination. Factors that weigh in favor of patent-eligibility satisfy the criteria of the machine-or transformation test or provide evidence that the abstract idea has been practically applied. Factors that weigh against patent-eligibility neither satisfy the criteria of the machine-or transformation test nor provide evidence that the abstract idea has been practically applied. Each case will present different factors, and it is likely that only some of the factors will be present in each application. **It would be improper to make a conclusion based on one factor while ignoring other factors** (emphasis added).

The outstanding Action has indicated that the rationale for finding that Claims 25, 29, 37 and 42 are directed to an abstract idea is limited to a conclusion that these claims do not satisfy the machine or transformation test, and cover both known and unknown uses of the concept of using priority information to de-multiplex base and enhancement layers.

Applicants respectfully submit that it is not proper to make a conclusion simply on this basis.

The Action has not addressed whether the alleged abstract idea found in Claims 25, 29, 37 and 42 has been practically applied. If this factor was to be addressed with regard to Claims 25, 29, 37 and 42, it would be clear that these claims are practically applied.

Moreover, with regard to the machine or transformation test, the Action has not properly weighed the factors in determining whether the apparatus clearly recited in the claim is a particular machine.

The “Interim Guidelines for Determining Subject Matter Eligibility for Process Claims in View of *Bilski v. Kappos*” states that

Where a machine or apparatus is recited or inherent in a patent claim, the following factors are relevant:

(1) The particularity or generality of the elements of the machine or apparatus; i.e., the degree to which the machine in the claim can be specifically identified (not any and all machines). Incorporation of a particular machine or apparatus into the claimed method steps weighs toward eligibility.

(2) Whether the machine or apparatus implements the steps of the method. Integral use of a machine or apparatus to achieve performance of the method weighs toward eligibility, as compared to where the machine or apparatus is merely an object on which the method operates, which weighs against eligibility.

(3) Whether its involvement is extrasolution activity or a field-of-use, i.e., the extent to which (or how) the machine or apparatus imposes meaningful limits on the execution of the claimed method steps. Use of a machine or apparatus that contributes only nominally or insignificantly to the execution of the claimed method (e.g., in a data gathering step or in a field-of-use limitation) would weigh against eligibility.

With regard to Claims 25, 29, 37 and 42 it is clear that each of these claims recite a machine or apparatus. In addition, with regard to item (1), the machine or apparatus recited in Claims 25 and 37 is identified as an information processing apparatus having at least encoding and packetizing parts. The machine or apparatus recited in Claims 29 and 42 is identified as an information processing apparatus having at least a decoding part. “Any and all” machines would not meet these respective definitions. Only specific machines that have encoding and packetizing parts or a decoding part could be identified as corresponding to the information processing apparatus of Claims 25, 29, 37 and 42, respectively. Thus, the specificity of the claimed machine or apparatus weighs toward eligibility.

With regard to item (2), the machine or apparatus is clearly recited as implementing both the encoding and packetizing steps recited in Claims 25 and 37 and the decoding step recited in Claims 29 and 42. Thus, the integral use of a machine or apparatus to achieve performance of the methods recited in these claims weighs toward eligibility.

With regard to item (3), the machine or apparatus clearly does not contribute only nominally or insignificantly to the execution of the claimed method. Thus, the fact that the machine or apparatus imposes meaningful limits on the execution of the claimed method steps weighs toward eligibility.

Instead of applying the above noted factors, the Action has asserted that since the information processing apparatus “is capable of being implemented on any machine that is capable of performing the recited steps” then the apparatus is not a particular machine. Applicants note that whether the apparatus is able to be implemented on any machine that is capable of performing recited steps is not a proper factor that should be used in determining whether an apparatus is a particular machine based on the courts holding in *Bilski* and the USPTO’s *Interim Guidelines*.

Accordingly, Applicants respectfully request that the rejection of Claims 25, 29, 37 and 42 under 35 U.S.C. §101, be withdrawn.

With regard to the rejection of Claims 31 and 44 under 35 U.S.C. §102(b) as anticipated by ISO/IEC, Applicants respectfully traverse this rejection.

The outstanding Action asserts that these claims “only recite[] a data structure that is stored on a computer readable medium” and “no functionality is tied to the recited elements and the claims do not require that the stored subject matter be later processed by a machine.” Further the Action asserts that “the claim [recites] merely the information content of a memory.” As a result, the Action asserts that “no patentable weight is given to the recited

data structure and the claim is interpreted to require...a non-transitory computer readable medium having stored thereon a data structure.”

Applicants respectfully traverse these assertions as improper and respectfully submit that Claims 31 and 44 clearly recite functional descriptive material recorded on a computer-readable medium. As is noted in MPEP §2106.01, “when functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized.”

In addition, MPEP §2106.01 states “in this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component.”

In Claims 31 and 44, the claims recite, and the Action acknowledges, that data structures are stored on the non-transitory computer readable medium. In addition, these claims clearly recite that the data structure is of an entire stream that is to be played back by a computer. Furthermore, the claims also recite, for example, that the TS packets each include transport priority information that indicates priority. These features are clearly functional descriptive material as they impart functionality when employed by a computer (e.g. they allow the computer to determine the priority for the TS packets.) Clearly, the claimed data structure defines structural and functional interrelationships between the data structure and the computer software and hardware components which permit the data structure's functionality to be realized. Thus, Applicants respectfully submit that the features of Claims 31 and 44 should be given patentable weight.

Furthermore, Applicants respectfully submit that, in light of the above comments, Applicants respectfully submit that Claims 31 and 44 patentably distinguish over ISO/IEC at least because this reference does not anticipate all of the features recited in Claims 31 and 44.

With regard to the rejection of Claims 24-27, 29-31, 33, 35, 37-39 and 42-44 under 35 U.S.C. §103(a) as unpatentable over ISO/IEC, Bruls and Yahata, the rejection of Claim 28 under 35 U.S.C. §103(a) as unpatentable over ISO/IED, Bruls, Yahata and Kelly, the rejection of Claims 32, 34, 40 and 55 under 35 U.S.C. §103(a) as unpatentable over ISO/IED, Bruls, Yahata and Kim, and the rejection of Claims 36, 41 and 46 under 35 U.S.C. §103(a) as unpatentable over ISO/IED, Bruls, Yahata and Wu, Applicants respectfully traverse these rejections in light of the following.

Specifically, Applicants have filed herewith a translation of Japanese priority document JP 2004-030214 which claims priority to February 6, 2004. In contrast, the cited Yahata reference is able only to claim priority to the October 7, 2004 provisional application. Thus, Applicants respectfully submit that in light of the perfection of priority in the present application, the §103(a) rejections applied in the outstanding Action and based on Yahata are overcome, at least, because Yahata is not prior art to the present application.

The Advisory Action mailed on March 23, 2011 states that

With regard to Applicant's Arguments that Yahata, et al. is not prior art with respect to the present application, Applicant's Arguments have been considered and are not persuasive. Although foreign priority has been properly perfected under 35 USC 119(a-d), no support under 35 USC 112, 1st paragraph can be found for the subject matter presented as being taught by Yahata, et al.

...Therefore, the issue becomes does Japanese Application No. 2004-030214 provide support for the claimed subject matter put fourth as being taught by Yahata, et al? Looking to the Final Office Action, dated 8 December 2010, Yahata is presented as teaching the claim element of using a priority indicator to de-multiplex the base and enhancement layers (See, for example, pages 15-18). Turning to Japanese Application No. 2004-030214, no mention is made of using a priority indicator for de-multiplexing base and enhancement layers. Therefore, the claimed subject matter taught by Yahata was not disclosed by Japanese Application No. 2004-030214 in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention and is not entitled to the benefit of the foreign priority date of 6 February

2004. Therefore, the rejection of the present application in view of Yahata is maintained, as the 8 November 2004 application date of the present application fails to predate the 102(e) date of 7 October 2004 given to Yahata.

Applicants respectfully traverse the assertions made in the Advisory Action regarding priority and submit that Japanese Priority Application No. 2004-030214 does provide §112, first paragraph support for the feature “packetizing the base stream and the first to n-th extension streams, *to which the transport priority information is added by the adding means*, into TS packets” (emphasis added).

For example, paragraph 0055 of JP2004-030214 in concert with paragraphs 0108 and 0133+ clearly disclose that the encoding units need to be encoded in sequence and the base stream is given PID a0 in order to ensure that this stream is given priority when decoding (as the decoder may only be able decode a limited number of streams such as only a0, a1 and a2).

Therefore JP2004-030214 clearly describes that transport priority information is included in the streams as the streams are given particular PID values which indicate priority.

The Action asserts that “no mention is made of using a priority indicator for de-multiplexing base and enhancement layers” in JP2004-030214. However, Applicants respectfully traverse the assertion that the claimed subject matter is not sufficiently supported by JP2004-030214. This is the case, at least, because JP2004-030214 clearly indicates that priority information is included in the base streams and the extension streams. In particular, the streams are assigned PID values which indicate priority (e.g. a0 is the highest priority). Evidence of this point is that JP2004-030214 describes that only a limited number of streams may be able to be decoded, with the streams being selected for decoding based on the PID (e.g. a0, a1 and a2).

Thus, Applicants respectfully submit that the features recited in Claims 24-46 are supported by JP2004-030214.

Accordingly, Applicants respectfully request that the rejections of 24-46 under 35 U.S.C. §103(a) based on Yahata in combination with other cited references, be withdrawn.

In addition, with regard to new Claims 47-60, Applicants respectfully submit that these claims also patentably distinguish over ISO/IED, Bruls, and Yahata.

For instance, the Action cites the “PID” of ISO/IED as corresponding to the first ID which is added to the stream encoded by the encoding means among the base stream and the first to n-th extension streams and which identifies the entire stream. With regard to the second ID that differs from the first ID and respectively distinguishes the base stream from the first to n-th extension streams, it would not be possible to assert that the separate PID of Bruls corresponds to this feature. This is the case, at least, because neither ISO/IED nor Bruls discloses assigning two PIDs to each of the base stream and the extension streams. In ISO/IED, a single PID is assigned to all streams. In Bruls, different PIDs are assigned to the base stream and extension streams. Neither of these references discloses both a first ID identifying the entire stream and a second ID differing from the first ID that respectively distinguishes the base stream from the first to n-th extension streams. In addition, Yahata does not cure these deficiencies of ISO/IED and Bruls.

Consequently, in view of the present amendment, and in light of the above discussion, the pending claims as presented herewith are believed to be in condition for formal allowance, and an early and favorable action to that effect is respectfully requested

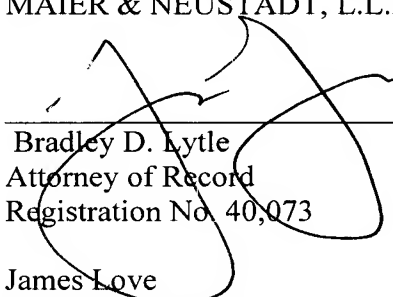
Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 07/09)



Bradley D. Lytle
Attorney of Record
Registration No. 40,073

James Love
Registration No. 58,421

5198941_1